

ESTTA Tracking number: **ESTTA87359**

Filing date: **06/27/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91161817
Party	Defendant Motorola, Inc. Motorola, Inc. 1303 East Algonquin Road Schaumburg, IL 60196
Correspondence Address	Thomas M. Williams Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610
Submission	Answer
Filer's Name	John Gabrielides
Filer's e-mail	officeactions@brinkshofer.com, jtg@brinkshofer.com
Signature	/jtg/
Date	06/27/2006
Attachments	Answer to Am Notice 062705 F.pdf ( 5 pages )(92560 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC.,

Opposer,

v.

MOTOROLA, INC.,

Applicant.

Opposition No.: 91161817

App. No.: 78/235,618

Mark: SENSORY MARK  
(911 Hz tone)

ANSWER TO AMENDED NOTICE OF OPPOSITION

Motorola, Inc. (“Applicant”) answers the Amended Notice of Opposition as follows.

For the Board’s convenience, each allegation in the Notice is set forth below and followed by

Applicant’s answer thereto.

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 17 million subscribers to its services nationwide.

ANSWER: Applicant admits that Opposer is one of the largest providers of cellular telephone services in the United States. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 1, and therefore, denies the allegations.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer’s cellular telephone and dispatch services.

ANSWER: Applicant admits that it has a long-standing business relationship with Opposer. Applicant admits that it is a manufacturer of MOTOROLA phones and phone accessories that function on MOTOROLA network infrastructure operated by Opposer, and which phones and accessories are sold to Opposer for resale to Opposer’s cellular service

customers. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 2, and therefore, denies the allegations.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

ANSWER: Applicant admits that it is a manufacturer of MOTOROLA phones and phone accessories that are sold to Opposer's direct competitors for resale to cellular service customers. Applicant is without information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 3, and therefore, denies the allegations.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("the 911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

ANSWER: Applicant admits the allegations of paragraph 4.

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

ANSWER: Applicant admits the allegations of paragraph 5.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

ANSWER: Applicant admits the allegations of paragraph 6.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows: "[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON."

ANSWER: Applicant admits the allegations of paragraph 7.

8. Applicant's response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as "[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the

availability to speak.” The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

ANSWER: Applicant admits the allegations of paragraph 8.

9. Upon information and belief, Applicant has not used the 911 Hz tone as a mark in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

ANSWER: Applicant denies the allegations of paragraph 9.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

ANSWER: Applicant denies the allegations of paragraph 10.

11. Opposer is the owner of a mark consisting of a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON (“Nextel Chirp”), and of Federal Trademark Application Serial No. 78/575,442, for registration of the Nextel Chirp in connection with “Telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone communication services; Wireless Internet access services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; Wireless communications services,” in International Class 38 (“Nextel Chirp Application”).

ANSWER: Applicant admits that Opposer has filed a Federal Trademark Application that has been assigned Serial No. 78/575,442 and that the goods identified in the application are identified within the quotation marks in paragraph 11. Applicant denies all other allegations of paragraph 11.

12. Opposer has a direct commercial interest in preventing improper federal registration of the 911 Hz tone as a trademark. For many years, Opposer has used the Nextel Chirp extensively in the marketing and promotion of its services. Opposer has spent many millions of dollars on advertising and other forms of marketing that feature the Nextel Chirp as a mark. Upon information and belief, Applicant has indicated that it may assert any federal registration it may obtain for the 911 Hz tone against Opposer, by seeking to prevent Opposer

from obtaining products that emit the Nextel Chirp from suppliers other than Applicant, or from marketing Opposer's own services under the Nextel Chirp, or from enjoying exclusive use of the Nextel Chirp vis-à-vis Opposer's competitors who acquire products from Applicant, or from obtaining federal trademark registration of the Nextel Chirp. Each or any of these events will cause injury to Opposer and impinge on its rights. Accordingly, Opposer will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application.

**ANSWER:** Applicant denies the allegations of paragraph 12.

### **AFFIRMATIVE DEFENSES**

(A) Opposer lacks standing to oppose the subject application.

(B) Opposer's Amended Notice of Opposition fails to state a claim upon which relief can be granted.

(C) Applicant's 911 Hz Tone mark has acquired distinctiveness.

WHEREFORE, Applicant prays that the Amended Notice of Opposition be dismissed in its entirety with prejudice and that a registration issue to Applicant for its 911 Hz Tone mark.

Respectfully submitted,

MOTOROLA, INC.

Dated: June 27, 2006

By: 

John T. Gabrielides

Thomas M. Williams

Elisa M. Valenzona

BRINKS HOFER GILSON & LIONE

P.O. Box 10395

Chicago, IL 60610

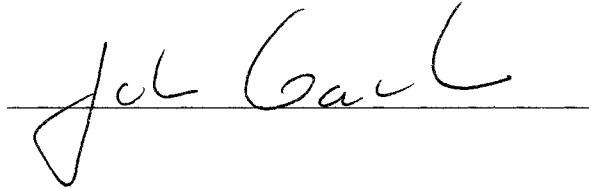
Attorneys for Applicant

**Certificate of Service**

The undersigned hereby certifies that a true and correct copy of the foregoing  
**ANSWER TO AMENDED NOTICE OF OPPOSITION** was served on Opposer's  
counsel by first class mail, postage prepaid, addressed as follows:

John I. Stewart, Jr.  
Michael H. Jacobs  
Karen Hermann  
Crowell & Moring, LLP  
P.O. Box 14300  
Washington, D.C. 20004-4300

on June 27, 2006.

A handwritten signature in cursive script, reading "Joel Gault", is written over a horizontal line.